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09/456,647 12/08/99 HOWARD

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EXAMINER

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Washington, D.C. 20231

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 09/456,647

Filing Date: 12/08/1999

Appellant(s): Howard et al.

T. Murray Smith
For Appellant

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EXAMINER'S ANSWER

This is in response to Appellant's brief on appeal filed 07/09/2001.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 7-8, and 24-26 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,740,549

Reilly et al.

4/1998

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(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

35 USC 102(e) rejection:

1. Claims 7-8, and 26 are rejected under 35 U. S. C. 102(e) as being anticipated by Reilly et al. (Patent No. 5,740,549).

As per claim 7, Reilly discloses an information and advertising distribution system and method comprising:

Storing contents and advertisement in a database (col. 6, lines 46-50 and col. 12, lines 6-14) which reads on “creating an electronic publication which includes at least one content item and at least one advertising item”.

Accessing the electronic content by a user (col. 6, lines 57-61) which reads on “permitting a user to access the electronic publication”; and

Displaying the advertisements after a time interval (col. 11, lines 40-52) which reads on “presenting the advertising item to the user of the electronic publication after passage of a predetermining amount of time the publication has been in use”.

As per claim 8, Reilly discloses an information and advertising distribution system and method comprising:

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Storing contents and advertisement in a database (col. 6, lines 46-50 and col. 12, lines 6-14) which reads on “creating an electronic publication which includes at least one content item and at least one advertising item”.

Accessing the electronic content by a user (col. 6, lines 57-61) which reads on “permitting a user to access the electronic publication”; and

Showing of an advertisement to a subscriber when a news item is being viewed (col. 13, lines 61-67 and col. 14, lines 1-14) which reads on “presenting the advertising item to the user of the electronic publication in response to the access of a specific content item”.

As per claim 24, Reilly discloses the claimed limitation “wherein the electronic publication includes a plurality of advertisement items, and wherein said presenting step is carried out by successively presenting the advertising items to the user of the electronic publication at respective predetermined points in time which are spaced from each other by the predetermined amount of time” by displaying plurality of advertisements at different time interval (col. 5, lines 24-34).

As per claims 25, Reilly discloses the claimed limitation “including the step of maintaining information about the amount of time which the user spends reading the electronic publication during each access thereto, and setting the predetermined amount

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as a function of such information” by monitoring amount of time a subscriber spends viewing an advertisement. Note column 5, line 61 to column 6, line 10.

As per claim 26, Reilly discloses the claimed limitation “wherein said presenting step is carried out by presenting the advertising item to the user in response to the access by the user of a predetermined part of the specific content item” by displaying advertisement to the subscriber when the subscriber clicks on a specified items (col. 13, lines 38-48).

(11) Response to Argument

35 USC 102(e) rejection:

Issue 1: Section 102 (b) rejection:

A. Appellants have cited the court cases defining the use of prior art under 35 USC 102(e). While the examiner does not dispute the standard set forth by the Appellant, the examiner would like to add that the examiner is not limited only to Appellant’s interpretation of what is being recited in the claims. Rather, office personnel are to give claims their broader reasonable interpretation in light of the supporting disclosure.” (See *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) and *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) cited in M.P.E.P. § 2111). This is because Appellant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the

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possibility that the claims, once issued, will be interpreted more broadly than justified. (See M.P.E.P. §2111).

B. Appellants discussed each claim that has been rejected by Reilly (US 5,740,549).

B. Claim 8 (Group 1).

Appellants asserted that Reilly fails to disclose presenting the advertising item to the user of the electronic publication in response to the access of a specific content item. The examiner disagrees with the Appellant's preceding assertion. The examiner notes that when the claim is interpreted as broadly and reasonably, Reilly clearly discloses "presenting the advertisement item to the user of the electronic publication in response to the access of a specific content item" by displaying the advertisement to the user when the user accesses a news item (i.e., "specific content item"). (See figures 5 and 6, and column 6 line 57 to column 7 line 20).

D. Claim 26 (Group 2).

Appellants asserted that Reilly fails to teach presenting the advertising item to the user in response to the access by the user of a predetermined part of the specific content item. The examiner disagrees with the Appellant's preceding assertion. The examiner notes that when the claim is interpreted as broadly and reasonably, Reilly discloses displaying the advertisement when the user clicks on a category button. That is

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to say, the clicking on the “category” button constitutes accessing “part of the specific content” of the item. (See column 13, line 61 to column 14 line 6).

E. Claims 7 and 24 (Group 3).

Appellants asserted that Reilly fails to disclose presenting the advertisement item to the user of the electronic publication after a passage of a predetermined amount of time during which the electronic publication has been in use. The examiner disagrees with the Appellant’s preceding assertion. The examiner notes that Reilly clearly discloses presenting the advertisement item to the user at a “predetermined” time interval (e.g., 30 seconds) (See column 5, lines 25-34, and column 13 line 61 to column 14 line 6).

F. Claim 25 (Group 25).

Appellants asserted that Reilly does not teach maintaining information about the amount of time which the user spends reading the electronic publication during each access thereto, and setting the predetermined amount of time as a function of such information. The examiner disagrees with the Appellant’s preceding assertion. The examiner notes that when the claim is interpreted as broadly and reasonably, Reilly does disclose tracking the time a user spend viewing/reading non-advertisement item. The time is being stored in a database in order to track the time and information of the user when using the system, which is equivalent to “setting the predetermined amount of time

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as a function of such information". (See column 5 line 51 to column 6 line 10, and column 9 lines 18-33).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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September 25, 2001.

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